

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF:

Art Unit: 1625

Rene HERSPERGER et al.

Examiner: Mabry, John

APPLICATION NO: 10/597,753

FILED: September 20, 2006

FOR: CHEMOKINE RECEPTORS ANTAGONIST

MS: General

Commissioner for Patents

PO Box 1450

Alexandria, VA 22313-1450

PETITION REGARDING PATENT TERM ADJUSTMENT UNDER C.F.R. §1.705(b)

Sir:

In accordance with 37 C.F.R. § 1.705(b), Applicant hereby applies for patent term adjustment under 35 U.S.C. § 154(b) of 538 days. This application is being filed with the payment of the issue fee, as required by 37 C.F.R. § 1.705 (b).

I. Fee

As required by 37 C.F.R. § 1.705(b)(1), this application is accompanied by a request to charge Deposit Account No. **50-4409** for \$ 200.00 to cover the required fee (as defined in 37 C.F.R. § 1.18(e)). Please charge any deficiencies or any additional fees due in response to this request to Deposit Account **50-4409**.

II. Statement of the Facts Involved

A. Correct Patent Term Adjustment

The Notice of Allowance, which was mailed on June 21, 2010, indicated a preliminary Patent Term Adjustment of 452 days.

Patentee has calculated an initial patent term adjustment of 538 days based on the following facts:

Relevant Dates

The above identified application has a 35 U.S.C. §371 filing date of September 20, 2006.

The first Office Action, which was a Restriction Requirement, was mailed on June 10, 2009, resulting in a PTO delay of 568 days beyond the 14 months provided by 35 U.S.C. §154(b).

A Response by Patentee was filed July 8, 2009, within the 3 months provided by 35 U.S.C. §154(b).

An Information Disclosure statement was filed on August 7, 2009, resulting in an applicant delay of 30 days beyond the 3 months provided by 35 U.S.C. §154(b).

A non-final office action was mailed October 20, 2009, within the 4 months provided by 35 U.S.C. §154(b).

A Response by Patentee was filed November 18, 2009, within the 3 months provided by 35 U.S.C. §154(b).

A non-final office action was mailed February 3, 2010, within the 4 months provided by 35 U.S.C. §154(b).

A Response by Patentee was filed April 19, 2010, within the 3 months provided by 35 U.S.C. §154(b).

A Notice of Allowance was mailed June 21, 2010, within the 4 months provided by 35 U.S.C. §154(b).

The issue fee has been paid on September 22, 2010 in a paper accompanying the instant petition, within the 3 months provided by 35 U.S.C. §154(b).

Accordingly, the initial PTO adjustment based on delay under 35 U.S.C. § 154(b)(2)(A) is 538 days.

There were 30 days of Applicant delay under 35 U.S.C. § 154(b)(2)(C).

Accordingly, the sum of the 35 U.S.C. § 154(b)(2)(A) delay (568 days) less Applicant delay days (30 days) results in an initial PTA of 538 days.

The initial PTA printed on the Notice of Allowance is only 452 days, which the USPTO is presumed to have calculated using December 14, 2007 as a 371(c) date, date when the USPTO withdrew from Applicant's account the fee for late payment of the oath/declaration. However, Applicants authorized such payment of fee on September 20, 2006; therefore the 371(c) date for purpose of patent term adjustment calculation is September 20, 2006. Applicants therefore respectfully request reconsideration of the initial PTA calculation.

B. Terminal Disclaimer

The above-identified patent is not subject to a Terminal Disclaimer.

C. Reasonable Efforts

Any applicant delays under 37 C.F.R. § 1.704 are set forth above. There were no other circumstances constituting a failure to engage in reasonable efforts to conclude processing of examination of the above-identified application, as set forth in 37 C.F.R. § 1.704.

Re

spectfully submitted,

Novartis Institutes for BioMedical Research, Inc.
220 Massachusetts Avenue
Cambridge, MA 02139
(617) 871-5027

/Sophie Binet Cross/_____
Sophie Binet Cross
Agent for Applicant
Reg. No 59,494

Date: September 20, 2010